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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,983	12/19/2001	Bartley Dean Maxon	DC4969	4816

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EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,983

Applicant(s)

MAXON ET AL.

Examiner

San-ming Hui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The outstanding rejections of claims 7-12 under 35 USC 112, second paragraph have been withdrawn in view of the showing in McCutcheon's 2001 Volume 1, "Emulsifiers & Detergents", page 320, submitted with the Brief of Appeal filed July 31, 2002.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US Patent 6,207,717 B1 from the IDS received December 19, 2001) in view of Schilling, Jr. et al. (US Patent 4,150,048), Schulz, Jr. et al. (US Patent 5,654,362 from the IDS received December 19, 2001), Remington (Remington's Pharmaceutical Sciences, 18th ed., 1990, page 1314), and Zhang (US Patent 5,889,108), references of record in the previous office action mailed July 16, 2002.

Lin et al. teaches a water-in-oil emulsion comprising vitamin E and an elastmeric silicone polyether which can be used in the preparation of shaving soaps, shaving lotion, and shaving lathers (See particularly the abstract; also col. 12, line 14-15).

Lin et al. does not expressly teach the herein claimed linear silicone polyether, used as a surfactant in the amount of 0.2-3.0 percent by weight, be incorporated in the composition. Lin et al. does not expressly teach the herein claimed α,ω -diene-crosslinked silicone elastomer in the amount of 0.1-4.0 percent by weight be incorporated in the composition. Lin et al. does not expressly teach decamethylcyclopentasiloxane as solvent be incorporated into the composition. Lin et al. does not expressly teach the use of second nonionic organic emulsifier in the weight percent of to be 0.1-4.0 be incorporated in the composition.

Schilling, Jr. et al. teaches a linear silicone polyether, with polyoxyethylene or polyoxyethylene-polyoxypropylene copolymeric units grafted onto a silicone backbone, which is useful as surfactant in the preparation of aerosol for shaving cream (See particularly the abstract; also col. 6, lines 2- col. 7, line 32; also col. 11, line 29-36). Schilling, Jr et al. teaches the weight percent of linear silicone polyether to be 0.5-2.0 (See particularly col. 13, line 12-13).

Schulz, Jr et al. teaches a α,ω -diene-crosslinked silicone elastomer, without oxyalkylene units, to be useful in silicone paste which can be used in the preparation of cosmetic products such as shaving lotion and facial cleansers (See particularly the abstract and claim 13). Schulz, Jr et al. teaches the weight percent of α,ω -diene-crosslinked silicone elastomer to be about 7.8% (See particularly col. 6, lines 42-65, Example III). Schulz, Jr et al. also teaches that α,ω -diene-crosslinked silicone elastomer could improve the substantivity of the formulation when applied onto the skin.

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Schulz, Jr et al. teaches the herein claimed α,ω -diene-crosslinked silicone elastomer has the unique property of being easily rubbed-in on the skin (See col. 2, line 11-21).

Zhang teaches decamethylcyclopentasiloxane, a thickening solvent, with a silicone elastomer or silicone paste are useful in preparation of emulsion useful for shaving lotion, shaving lathers or delivery systems of vitamins (See particularly the abstract, also col. 7, lines 12-29). Zhang also teaches that the silicone paste would be easily emulsified when decamethylcyclopentasiloxane is utilized (See particularly the abstract).

Remington teaches that polysorbate 20, also known as TWEEN 20, is a commonly used as a nonionic organic surfactant (See page 1314).

It would have been obvious to one skill in the art when the invention was made to incorporate the herein claimed linear silicone polyether, polysorbate 20 (nonionic organic emulsifier), and decamethylcyclopentasiloxane (a solvent) in the herein claimed amount, into the vitamin E water-in-oil emulsion composition of Lin et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute α,ω -diene-crosslinked silicone elastomer for the elastmeric silicone polyether of Lin et al.

One of ordinary skill in the art would have been motivated to incorporate the herein claimed linear silicone polyether, polysorbate 20 (nonionic organic emulsifier), and decamethylcyclopentasiloxane (a solvent) in the herein claimed amount, into the vitamin E water-in-oil emulsion composition of Lin et al. One of ordinary skill in the art would have been motivated to substitute α,ω -diene-crosslinked silicone elastomer for

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the elastmeric silicone polyether of Lin et al. The reasons are as followed: the incorporation of a linear silicone polyether, with polyoxyethylene or polyoxyethylene-polyoxypropylene copolymeric units grafted onto a silicone backbone into the composition of Lin et al. would provide the benefit of emulsifying activity to form the water-in-oil emulsion. The incorporation of decamethylcyclopentasiloxane, a thickening solvent, into the composition of Lin et al. would provide the benefit of making the water-in-oil emulsion easily because it can be easily emulsified with water and the silicone paste. The incorporation of any well-known surfactant, such as polysorbate 20, into the water-in-oil emulsion of Lin et al. would simply be considered as adding a second surfactant into the composition to stabilize the emulsion. Finally, the substitution of α,ω -diene-crosslinked silicone elastomer for the an elastmeric silicone polyether into the composition of Lin et al. would provide the benefit of improving the lubrication of the formulations when applied onto the skin due to the unique property of the α,ω -diene-crosslinked silicone elastomer.

Possessing the teachings of the cited prior art, one of ordinary skill in the art would reasonably expect to incorporate the herein claimed ingredients together into the water-in-oil emulsion composition of Lin et al., in view of the above mentioned benefits that each component can contribute, absent evidence to the contrary.

Response to Arguments

Applicant's remarks filed July 31, 2002 in the Brief of Appeal in regard to the teachings of Schulz and Schilling have been considered, but are not found persuasive.

The reasons of incorporating the herein claimed silicone elastomer of Schulz, Jr. et al. and the linear silicone polyether of Schilling, Jr. et al. are because of the beneficial properties those compounds possess.

Applicant's other remarks filed July 31, 2002 in the Brief of Appeal believed to be addressed in the rejection under 35 USC 103 above. The motivation to combine the teachings of the cited references is clearly provided. Therefore, the cited prior art would render the claims obvious.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-


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1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui
September 30, 2002


SREENI PADMANABHAN
PRIMARY EXAMINER

9/30/02